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Filing date: **01/21/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91119510
Party	Plaintiff GUESS?, INC. ,
Correspondence Address	MICHAEL J MACDERMOTT CHRISTIE PARKER & HALE PO BOX 7068 PASADENA, CA 91109
Submission	Motion for Summary Judgment
Filer's Name	Michael J. MacDermott
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Signature	/Michael J. MacDermott/
Date	01/21/2005
Attachments	Motion for Summary Judgment.pdf (16 pages)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

GUESS?, INC.	Opposition No. 91119510
Opposer,	
v.	OPPOSER'S MOTION FOR SUMMARY JUDGMENT AND SUSPENSION PURSUANT TO RULE 56(a) OF THE FEDERAL RULES OF CIVIL PROCEDURE AND RULES 2.127(e) AND 2.117(b) OF THE TRADEMARK RULES OF PRACTICE; DECLARATION OF THERESA MCMANUS IN SUPPORT THEREOF
DIRK N. ROCKHOLD	
Applicant.	

Opposer Guess?, Inc. hereby moves the Honorable Board pursuant to Rule 56(a) of the Federal Rules of Civil Procedure and Rule 2.127(e) of the Trademark Rules of Practice for summary judgment in its favor on the grounds that there is no genuine issue of material fact and opposer is entitled to judgment as a matter of law sustaining opposer's opposition to application Serial No. 75/660,655. The grounds for this motion are set forth in the following memorandum or points and authorities and is supported by the annexed Declaration of Theresa McManus.

Opposer moves for a suspension of proceedings under Rule 2.117(b) pending the Board's decision on Opposer's Motion for Summary Judgment. Opposer is concurrently moving the Board under Rule 15(a) of the Federal Rules of Civil Procedure for leave to amend the notice of opposition.

Memorandum of Points and Authorities

As stated above, opposer is seeking leave of the Board to amend the notice of opposition to allege two additional grounds therefore, namely, abandonment and applicant's inability to

lawfully use in commerce the mark for which registration is sought in view of the settlement agreement between the parties.

As detailed in the McManus declaration annexed hereto and as is evident from the Agreement attached thereto as Exhibit 4, the parties settled this opposition in June 2002. On July 29, 2002, applicant filed a proposed amendment of the drawing and an amendment of the services.

In an order dated February 27, 2003 the Board declined to approve the amendment on the grounds that the proposed amendment would materially alter the character of the mark. Under the parties' agreement, applicant was required to withdraw the application, but has failed to do so. Applicant is therefore in breach of the agreement.

Opposer has sought for the past months to secure applicant's compliance with the agreement but has been unsuccessful. Accordingly, opposer is filing this motion for summary judgment to obtain the relief to which it is entitled.

In support of this motion opposer relies upon the Board's decision in Vaughn Russell Candy Co. v. Cookies in Bloom Inc., 47 USPQ2d, 1635 (TTAB 1998) which is factually similar to the present case. In the Vaughn Russell Candy case, the parties had entered into a settlement of the opposition requiring the applicant to amend its mark. The Board denied the amendment and the opposer then filed for summary judgment on the grounds of abandonment and applicant's inability to lawfully use in commerce the mark for which registration was sought in view of the settlement agreement between the parties. The Board's decision actually concerned the opposer's second motion for summary judgment, the first motion for summary judgment having been denied because the opposer had failed to seek amendment of the notice of opposition.

So too in this case, the applicant has agreed not to use the mark as filed and such a contractual commitment constitutes an abandonment. Further, since applicant has agreed not to use the mark in issue, as the Board stated it "clearly cannot assert the exclusive right to use in commerce the mark for which registration is sought." 47 USPQ2d at page 1638.

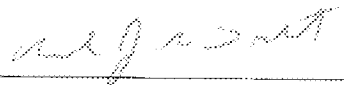
For the foregoing reasons, we urge that this Motion for Summary Judgment be granted and that the opposition be sustained.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

Date January 21, 2005

By



Michael J. MacDermott
Attorneys for Opposer
P.O. Box 7068
Pasadena, California 91109-7068
626/795-9900

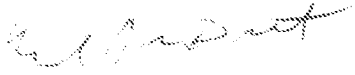
MM/edb

CERTIFICATE OF SERVICE

I hereby certify that on January 21, 2005, the foregoing **OPPOSER'S MOTION FOR SUMMARY JUDGMENT AND SUSPENSION PURSUANT TO RULE 56(a) OF THE FEDERAL RULES OF CIVIL PROCEDURE AND RULES 2.127(e) AND 2.117(b) OF THE TRADEMARK RULES OF PRACTICE; DECLARATION OF THERESA MCMANUS IN SUPPORT THEREOF** is being served by mailing a copy thereof by first-class mail addressed to:

John E. Cepican, Esq.
STURM & FIX LLP
101 West Second Street
Suite 304
Davenport, Iowa 52801-1813

By



Michael J. MacDermott
Christie, Parker & Hale, LLP
P.O. Box 7068
Pasadena, CA 91109-7068

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DECLARATION OF THERESA McMANUS

I, Theresa McManus, hereby declare and state that:

1. I am the Intellectual Property Counsel of Opposer Guess?, Inc., a Delaware corporation of 1444 South Alameda Street, Los Angeles, California 90021 (hereinafter referred to as "Guess"). I have held that position since June 2003. As Intellectual Property Counsel of Guess? I am responsible for and knowledgeable relative to the protection of the company's trademark rights and the enforcement thereof. This declaration is based upon my personal knowledge and upon information derived from records of the company kept in the ordinary course of business.

2. Guess and its predecessors have been in business for over twenty years and during that time have continuously used the mark GUESS alone and in combination with other terms for a wide variety of consumer goods and services. Guess is a world famous fashion company and has advertised its products on television and its products and models have been featured in the entertainment industry.

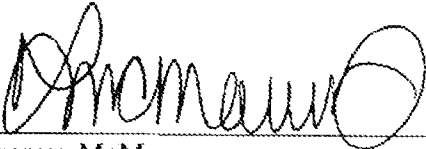
3. On or about June 27, 2000 Guess filed this opposition proceeding. The parties had engaged in a certain amount of discovery, after which they entered into an agreement to settle the opposition. Annexed hereto as Exhibit A is a copy of the executed Agreement which was effective June 24, 2002.

4. Under the Agreement, the applicant was to either withdraw this application or amend the mark to the design shown in Exhibit 4 to the Agreement. In either case, the applicant was required to not use or seek registration of the mark as shown. See Paragraph 2 to the agreement.

5. The Trademark Board declined to enter the applicant's amendment of the mark on the grounds that the change was material and despite our counsel's request to the applicant, he has failed to withdraw this application pursuant to the agreement. The applicant's breach of the Agreement is damaging to the trademark rights of Guess.

6. I declare under penalty of perjury that the foregoing is true and correct.

Dated: January 20, 2005


Theresa McManus

AGREEMENT

This Agreement is made as of the 24th day of June, 2002, by and between Guess?, Inc., a Delaware corporation, of 1444 South Alameda Street, Los Angeles, California 90021 (hereinafter "Guess"), and Dirk N. Rockhold, an individual, of 2728 E. 53rd Street, Davenport, Iowa 52807 (hereinafter "Rockhold").

WHEREAS, Guess has used the trade name and mark GUESS, alone and in combination with other terms and designs (hereinafter the "GUESS Marks"), for twenty years in connection with a wide variety of consumer products and services, has advertised its products on television and has sponsored a variety of televised events;

WHEREAS, Guess has expended hundreds of millions of dollars in the advertising and promotion of the GUESS Marks and has achieved billions of dollars in sales revenue for GUESS brand products throughout the world over the past two decades;

WHEREAS, the GUESS Marks have achieved substantial fame and recognition in the United States and around the world for the broad line of GUESS products and services;

WHEREAS, Rockhold has filed Application Serial No. 75/660,655 for registration of the mark GUESTV and Design in Class 9, as shown in Exhibit 1 annexed hereto, for preparing audio-video presentations for use in advertising in the lodging industry;

WHEREAS, GUESS has filed Opposition No. 119,510 to Rockhold's Serial No. 75/660,655 alleging a likelihood of confusion with the GUESS Marks;

WHEREAS, the parties wish to avoid a likelihood of confusion in the use and registration of their respective marks;

NOW, THEREFORE, in view of the mutual covenants contained herein, it is agreed as follows:

1. Within thirty (30) days of the effective date of this Agreement, Rockhold, through his counsel of record, shall file a withdrawal of Serial No. 75/660,655 with the consent of Guess in the form shown in Exhibit 2 annexed hereto or shall, with the consent of Guess, amend the mark to GUEST TV and Design as shown in Exhibit 4 annexed hereto and amend the services to "preparing audio-video presentations for use in cable television advertising in the lodging industry".

2. Rockhold shall not hereafter use or seek registration of the mark GUESTV, alone or in combination with other terms or designs.

3. Guess hereby consents to and shall not interfere with or object to the use and registration by Rockhold of the marks GUEST TV and GUEST TELEVISION with the design of

a cable head-end symbol as shown in Exhibits 3 and 4 annexed hereto in connection with preparing audio-video presentations for use in cable television advertising in the lodging industry.

4. Rockhold consents to and shall not interfere with or object to the use and registration of the marks GUESS TV or GUESS TELEVISION by Guess for any goods or services.

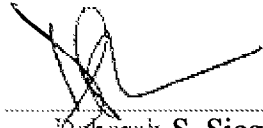
5. Rockhold warrants and represents that he is the sole and exclusive owner of the rights in and to the mark GUESTV and Design and Application Serial No. 75/660,655 and that no rights are or were held by him in partnership with Brian J. Benak Corporation.

6. This Agreement shall be binding upon and inure to the benefit of the parties, their assigns, related companies and successors in interest.

IN WITNESS WHEREOF, the parties have executed this Agreement as of the date first above written.

GUESS?, INC.

By


Deborah S. Siegel

General Counsel and Secretary

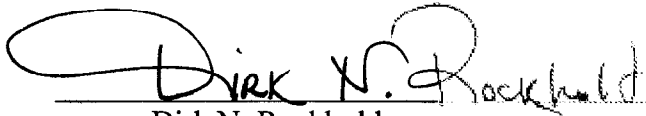

Dirk N. Rockhold



EXHIBIT 1



N E E D S A S P A T E N T A N D T R A D E M A R K O F F I C E

Trademark Electronic Search System (TESS)

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Record 1 out of 1

Check Status

(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)



Word Mark	GUESTV
Goods and Services	IC 009. US 021 023 026 036 038. G & S: Preparing audio-video presentations for use in advertising in the lodging industry
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	260102 260521
Serial Number	75660655
Filing Date	March 15, 1999
Filed ITU	FILED AS ITU
Published for Opposition	February 1, 2000
Owner	(APPLICANT) Rockhold, Dirk N. Citizenship of General Partners: Dirk N. Rockhold, Brian J. Benak Corporation - Iowa PARTNERSHIP UNITED STATES 2728 E. 53rd St. Davenport IOWA 52807
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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EXHIBIT 2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

GUESS?, INC.

Opposer,

v.

DIRK N. ROCKHOLD

Applicant.

Opposition No. 119,510

WITHDRAWAL OF APPLICATION
WITH CONSENT

Applicant, through his undersigned counsel, hereby withdraws Application Serial No. 75/660,655.

Respectfully submitted,

HENDERSON & STURM LLP

Date _____, 2002

By _____
John E. Cepican, Esq.
Attorneys for Applicant
101 West Second Street, Suite 204
Davenport, Iowa 52801-1813

Opposition No. 119,510

CONSENT

Opposer, through its undersigned counsel, hereby consents to applicant's withdrawal of Application Serial No. 75/660,655.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

Date _____, 2002

By _____
Michael J. MacDermott
Attorneys for Opposer
P.O. Box 7068
Pasadena, California 91109-7068
626/795-9900

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EXHIBIT 3





EXHIBIT 4

